

Rec'd PET/PTO 30 JUL 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Bunichiroh FUJII, et al.**

Group Art Unit: 2151

Serial No.: 10/088,488

P.T.O. Confirmation No.: 4896

Filed: **March 26, 2002**

**FOR: CONTENTS FILE PLAY BACK PERMISSION METHOD, AND RECORDING  
MEDIUM HAVING RECORDED PLAY BACK SOFTWARE FOR PLAYING  
BACK CONTENTS FILE**

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International Division

**PETITION UNDER 37 CFR §1.47(a)**

Commissioner for Patents  
Washington, D.C. 20231

July 30, 2002

Sir:

It is hereby requested that the attached DECLARATION FOR U.S. PATENT APPLICATION, signed in behalf of one of the co-inventors, Mr. Bunichiro FUJII, by the other co-inventor, Mr. Akira MATSUBARA, be accepted under the provisions of 37 CFR §§1.47(a) and 1.64(b). The facts in support of this Petition are set forth in the accompanying Declaration by a person authorized to sign in behalf of the assignee, Sony Communication Network Corporation, namely, Ms. Eriko UCHIDA.

The last known address of Mr. Bunichiro FUJII is:

12-13, Honcho 2-chome, Funabashi-shi, Chiba-ken, 273-0005, Japan.

The Declaration by the person authorized to sign in behalf of the assignee sets forth that Mr. Bunichiro FUJII refused to sign, as presented by communications among Ms. Eriko UCHIDA and Ms. Yuka NARUSE (both members of the Intellectual Property Department at Sony Communication Network Corporation), and Mr. Masaro KIKUCHI (a supervisor at Sony

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Communication Network Corporation), including e-mail communications among them indicating a refusal by Mr. Bunichiro FUJII to sign the DECLARATION when presented with the entire patent application.

Enclosed herewith is a check in the amount of \$130.00 for the fee for this Petition, as required under 37 CFR §1.17(h). The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to our Deposit Account No. 01-2340.

Accordingly, please accept the executed attached DECLARATION FOR U.S. PATENT APPLICATION, signed by one co-inventor, Mr. Akira MATSUBARA, in behalf of the other co-inventor, Mr. Bunichiro FUJII, along with this Petition and the Declaration in Support of Petition Under 37 CFR §1.47, as being fully responsive to the Notice fo File Missing Parts dated June 13, 2002.

Respectfully Submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP



William L. Brooks  
Attorney for Applicants  
Reg. No. 34,129

WLB/led/jaz

Atty. Docket No. 020392  
Suite 1000, 1725 K Street, N.W.  
Washington, D.C. 20006  
(202) 659-2930



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Enclosures: Declaration in Support of Petition Under 37 CFR §1.47(a) with partial translations of e-mail communications

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Rec'd PET/PTO 30 JUL 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: FUJII, Bunichiroh, et al.

Group Art Unit: 2151

Serial No.: 10/088,488

Filed: March 26, 2002

P.T.O. Confirmation No.: 4896

FOR: CONTENTS FILE PLAY BACK PERMISSION METHOD, AND RECORDING  
MEDIUM HAVING RECORDED PLAY BACK SOFTWARE FOR PLAYING  
BACK CONTENTS FILE

DECLARATION IN SUPPORT OF PETITION UNDER 37 CFR §1.47(a)

Commissioner for Patents  
Washington, D.C. 20231

July 30, 2002

Sir:

I, Ms. Eriko UCHIDA, declare as follows:

1. I am a member of the Intellectual Property Department at Sony Communication Network Corporation, 7-35, Kitashinagawa, 4-chome, Shinagawa-ku, Tokyo, 140-0001, Japan, the Assignee of the above-captioned patent application, and I am authorized to sign this document;

2. Messrs. Bunichiro FUJII and Akira MATSUBARA are joint inventors of the above-captioned patent application;

3. Mr. Bunichiro FUJII refuses to sign the Declaration and Power of Attorney for the above-captioned patent application, and to join in the above-captioned patent application;

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4. Submitted herewith are communications among Mr. Eriko UCHIDA and Ms. Yuka NARUSE (Affiant and another member of the Intellectual Property Department of Assignee), Mr. Bunichiro FUJII (the inventor refusing to sign), and Mr. Masaro KIKUCHI (a supervisor at Assignee), including e-mail communications among them indicating a refusal by Mr. Bunichiro FUJII to sign the DECLARATION when presented with the entire application.

The date and time of the requests are as follows:

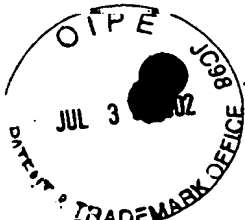
- a) April 22, 2002 at 15:16 hrs. from Naruse to Fujii. Request was made to the inventor to return the documents after signature.
- b) April 22, 2002 at 15:53 hrs. from Fujii to Naruse. Inventor refused to sign saying that "the invention is not worthy of filing applications in foreign countries."
- c) April 22, 2002 at 16:02 hrs. from Uchida to Fujii. Requested again to sign the documents.
- d) April 22, 2002 at 16:04 hrs. from Fujii to Uchida. Inventor refused again to sign the documents.
- e) April 30, 2002 at 10:33 hrs. from Uchida to Masaro Kikuchi. After repeated refusals by the inventor to sign the documents, Ms. Uchida abandoned her policy to make direct requests to the inventor and, instead, tried to let the inventor sign the documents through the influence of the chief (Kikuchi) of working group to which the inventor belonged at the time when he made the invention.
- f) May 30, 2002 at 14:12 hrs. from Uchida to Kikuchi Asked once again for Kikuchi's cooperation to let the inventor to sign the documents.

5. Mr. Bunichiro FUJII's last known residence address is: 12-13, Honcho, 2-chome, Funabashi-shi, Chiba-ken, 273-0005, Japan, and

6. I hereby declare that all of statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 187 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therefrom.

(signature) Eriko Uchida  
(authorized person from Sony)  
member of Intellectual  
Position: Property Department  
Date: July 8, 2002

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(Partial Translations of e-mail communications)

a) April 22, 2002 at 15:16 hrs. from Naruse to Fujii

"We sent you by interoffice mail service dated March 1, 2002 the Declaration and Assignment together with the English version of the entire specification for your execution. We are, however, not able to confirm the receipt thereof up to date.

Unless all of the above-described documents duly signed by you are in hand, we are not able to proceed with patent applications in foreign countries. Therefore, please execute them and urgently return them to Naruse.

When returning them to me, please be sure to give me a message to my mail address to the effect that they have been sent out so that I can trace it. Your cooperation is highly appreciated."

b) April 22, 2002 at 15:53 hrs. from Fujii to Naruse

"Something seems to have been sent me, but I do not remember well. I was so busy with various matters that I must have left the matter unattended. I will look for the documents.

As an inventor, I have no idea at all to file patent applications in foreign countries based on the invention in question. The invention is not worthy of doing so in point of quality.

Is it acceptable at all for me to return the documents as they are when found out (without execution on my part)?"

c) April 22, 2002 at 16:02 hrs. from Uchida to Fujii

"It is the policy of the company to file a patent application in the U.S.A. Could you please recognize the fact that the company regard the invention "CONTENTS FILE PLAY BACK PERMISSION METHOD, ..." important?

The documents in question are essential in filing with the USPTO; without the signing by yourself (Mr. Matsubara has already executed), the documents will not be accepted. Therefore, please be sure to return them after signing."

d) April 22, 2002 at 16:04 hrs. from Fujii to Uchida

"The policy to file patent applications in foreign countries is nothing but the one of the company; I cannot understand it. Therefore, please treat the matter accordingly."

e) April 30, 2002 at 10:33 hrs. from Uchida to Masaro  
Kikuchi

"The reason for Mr. Fujii's rejecting to sign the documents seems to be that the quality of the specification of the invention in question is not worthy of doing so. For your ready reference, the copies of the e-mail communications are attached hereinbelow (copies omitted)."

f) May 30, 2002 at 14:12 hrs. from Uchida to Kikuchi

"Regarding the signing by Mr. Fujii, for which I asked your cooperation the other day to use your influence on Mr. Fujii, is it still impossible to persuade him to sign the documents?"

Please inform me of the present status. Your cooperation is appreciated."



>> -----Original Message-----

>> From: Yuka Naruse [mailto:Naruse@scn.co.jp]

>> Sent: Monday, April 22, 2002 3:16 PM

>> To: bfujii@sm.sony.co.jp

>> Cc: bfujii@ba2.so-net.ne.jp; Eriko Uchida

>> Subject: 至急、書類の返却をお願い致します。

>> Importance: High

>>

>>

>> 藤井文一郎様

>>

>> 何時もお世話になっております。

>> S C N法務・知財セクションの成瀬です。

>> 3月1日付社内メール便にて「特許譲渡証書（英文）」をお送りし、自筆サイ

>> ン

>> のご記入をお願いした件ですが、本日までご返送を確認できておりません。

>>

>> サインをお願いしていた「特許譲渡証書（英文）」が揃わないと、国際特許の

>> 手続きができず、申請手続きが「保留」のままにありますので、大至急サインを

>> ご記入の上、S C N法務・知財セクションの成瀬宛ご返送ください。

>>

>> また、ご返送の際には、発送確認のため「発送した」と1メッセージで構いま

>> せんので、このメールアドレス宛ご連絡ください。

>>

>> ご多忙中のところ、大変申し訳ありませんが、よろしくお願い致します。

>>

>>

>> P.S. それから、こちらは急ぎませんが、2月20日付社内メール便でお送り

>> した「特願2002-0036265号」の譲渡証書もご捺印の上、ご返送手配

>> をお願い致します。

>>

>> 。o0○

>> 成瀬 由佳 / Yuka Naruse

>> naruse@scn.co.jp

>> ソニーコミュニケーションネットワーク株式会社

>> コーポレートコントロールディビジョン

>> 法務知財・SECセクション

>> 。o0○

>>

>>

=====

ソニーコミュニケーションネットワーク株式会社  
コーポレートコントロールディビジョン  
内田 絵理子

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>> 必ずサインしてご返却ください。

>>

>> 宜しくお願いします。

>>

>>

>> \*\*\*\*\* (藤井さん → 成瀬さん) \*\*\*\*\*

>>

>> On Mon, 22 Apr 2002 15:53:19 +0900

>> "藤井 文一郎" <bfujii@sm.sony.co.jp> wrote:

>> Forwarded by Eriko Uchida <uchida@scn.co.jp>

>> ----- Original Message -----

>> From: "藤井 文一郎" <bfujii@sm.sony.co.jp>

>> To: "'Yuka Naruse'" <Naruse@scn.co.jp>

>> Date: Mon, 22 Apr 2002 15:53:19 +0900

>> Subject: RE: 至急、書類の返却をお願い致します。

>> ----

>>

>>

>> 藤井です。

>> お疲れ様です。

>>

>> 何か送られてきたような気がします、

>> よく憶えておりません。私も色々業務が入ってきてしまい、

>> 失念してしまったのかもしれない。

>>

>> 探してみますが、、、

>>

>> 申請者として言わせていただければ、あの特許について

>> 海外特許まで出す気持ちは無いです。そこまで出来の良

>> い特許ではありません。

>>

>> 出てきたら、

>> そのままの返却でよろしいでしょうか？

>>

>> \*\*\*\*\* (成瀬さん → 藤井さん) \*\*\*\*\*

>>

>>> -----Original Message-----

>>> From: Yuka Naruse [mailto:Naruse@scn.co.jp]

>>> Sent: Monday, April 22, 2002 3:16 PM

>>> To: bfujii@sm.sony.co.jp

>>> Cc: bfujii@ba2.so-net.ne.jp; Eriko Uchida

>>> Subject: 至急、書類の返却をお願い致します。

>>> Importance: High

>>>

>>>



内田→藤井の最初のメールです。

Forwarded by Eriko Uchida <uchida@scn.co.jp>

----- Original Message -----

From: Eriko Uchida <uchida@scn.co.jp>

To: "藤井 文一郎" <bfujii@sm.sony.co.jp>

Date: Mon, 22 Apr 2002 16:02:54 +0900

Subject: Re[2]: 至急、書類の返却をお願い致します。

法務の内田です。横レスで失礼します。

以下の件ですが、米国出願は会社の決定した方針です。それだけ会社が「ねっとのおやつ」を重要視しているとお考えいただけますでしょうか？

それから、あの書類は米国特許庁に提出しなければならない必須書類で、藤井さんのサイン（すでに松原さんのサインはしてあります）がないと正式な出願として受理されませんので、お手数ですが、必ずサインしてご返却ください。

宜しくお願いします。

On Mon, 22 Apr 2002 15:53:19 +0900

"藤井 文一郎" <bfujii@sm.sony.co.jp> wrote:

>  
> 藤井です。  
> お疲れ様です。  
>  
> 何か送られてきたような気がしますが、  
> よく憶えておりません。私も色々業務が入ってきてしまい、  
> 失念してしまったのかもしれませんが。  
>  
> 探してみますが、、、  
>  
> 申請者として言わせていただければ、あの特許について  
> 海外特許まで出す気持ちは無いです。そこまで出来の良  
> い特許ではありません。  
>  
> 出てきたら、  
> そのままの返却でよろしいでしょうか？  
>

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藤井→内田宛の最後のメールです。

Forwarded by Eriko Uchida <uchida@scn.co.jp>

----- Original Message -----

From: "藤井 文一郎" <bfujii@sm.sony.co.jp>

To: "'Eriko Uchida'" <uchida@scn.co.jp>

Date: Mon, 22 Apr 2002 16:04:01 +0900

Subject: RE: Re[2]: 至急、書類の返却をお願い致します。

-----

藤井です。

> 以下の件ですが、米国出願は会社の決定した方針です。それだけ  
> 会社が「ねっとのおやつ」を重要視しているとお考えいただけます  
> でしょうか？

それはあなたの会社がそうなのであって、私には理解できません。  
よろしく願いいたします。

d)

----- Original Message Ends -----



最初に元上長（SCN時代の上司）に連絡を入れた際のメールです。

Forwarded by Eriko Uchida <uchida@scn.co.jp>

----- Original Message -----

From: Eriko Uchida <uchida@scn.co.jp>  
To: Masaro Kikuchi <kikuchi@scn.co.jp>  
Date: Tue, 30 Apr 2002 10:33:49 +0900  
Subject: Re[2]: 「ねっとのおやつ」米国出願について  
-----

内田です。

お手数おかけしますが、宜しくお願いします。

藤井さんが署名を拒否されている理由は、今回の出願が外国出願に相当するほど出来のいいものではないから、ということのようです。ご参考までに、いままでのメールの履歴（ちょっと長いですが）をコピーします。

e)

>> \*\*\*\*\* (藤井さん → 内田) \*\*\*\*\*

>>

>> 藤井です。

>>

>>> 以下の件ですが、米国出願は会社の決定した方針です。それだけ  
>>> 会社が「ねっとのおやつ」を重要視しているとお考えいただけます  
>>> でしょうか？

>>

>> それはあなたの会社がそうなのであって、私には理解できません。  
>> よろしく願いいたします。

>>

>> \*\*\*\*\* (内田 → 藤井さん) \*\*\*\*\*

>>

>> 法務の内田です。横レスで失礼します。

>>

>> 以下の件ですが、米国出願は会社の決定した方針です。それだけ  
>> 会社が「ねっとのおやつ」を重要視しているとお考えいただけます  
>> でしょうか？

>>

>> それから、あの書類は米国特許庁に提出しなければならない必須  
>> 書類で、藤井さんのサイン（すでに松原さんのサインはしてありま  
>> す）がないと正式な出願として受理されませんので、お手数ですが、

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発明者の元上長（SCN在席時の上司）に連絡した際のメールです。

Forwarded by Eriko Uchida <uchida@scn.co.jp>

----- Original Message -----

From: Eriko Uchida <uchida@scn.co.jp>  
To: Masaro Kikuchi <kikuchi@scn.co.jp>  
Date: Thu, 30 May 2002 14:12:07 +0900  
Subject: Re[3]: 「ねっとのおやつ」米国出願について  
-----

法務の内田です。

先日お願いした藤井さん署名の件ですが、やはりダメでしょうか？弁理士と相談して、なんとか署名ナシで手続きできないか検討していますが、まるっきり藤井さんの協力が得られないとなると、なかなか難しいというのが実情です。

ご多忙のところ大変申し訳ありませんが、状況をお知らせください。宜しくお願い致します。

On Tue, 30 Apr 2002 10:33:49 +0900  
Eriko Uchida <uchida@scn.co.jp> wrote:

>  
> 内田です。  
>  
> お手数おかけしますが、宜しくお願いします。  
>  
> 藤井さんが署名を拒否されている理由は、今回の出願が  
> 外国出願に相当するほど出来のいいものではないから、と  
> いうことのようにです。ご参考までに、いままでのメールの  
> 履歴（ちょっと長いですが）をコピーします。  
>  
>  
>>> \*\*\*\*\*（藤井さん → 内田）\*\*\*\*\*  
>>>  
>>> 藤井です。  
>>>  
>>>> 以下の件ですが、米国出願は会社の決定した方針です。それだけ

f)

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